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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,941	10/21/2003	Matthew T. Adams	481062.410	4028
35243 7590 01/25/2008 SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVENUE, SUITE 5400 SEATTLE, WA 98104-7092				
			EXAMINER DICUS, TAMRA	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 01/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/689,941

Applicant(s)

ADAMS ET AL.

Examiner

Tamra L. Dicus

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,9-11 and 30-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,9-11 and 30-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Due to applicant's amendments, the prior art rejections are withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 defines the medium separately from the composite which makes claim 4 indefinite since it attempts to define the medium as a combination with a composite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US 5569347 A to Obata et al.

Obata teaches a thermal transfer label (FIG. 1 and associated text) with superimposed (overlay) heat melt ink layers in yellow, cyan, magenta, and black colors (3, FIG. 1, and shown separated and overlaid in FIG. 3, 6M, 6Y) (any color lighter than black suffices as a light color layer, black being the darker color, between yellow and magenta, yellow is the light color, magenta is darker) via a thermal transfer printer on a transfer material layer 1, transferred to a porous receptor (composite) 4, FIG. 1 and associated text (of two or more resins (matrix) on a polypropylene film (embraces reinforcing material as it provides supportive characteristics to said resinous matrix). See: 2:20-68, 3:20-68, 5:15-25, 6:25-50. Obata does not teach “for adhering to a surface of a composite material of reinforcing material and a matrix” (instant claim 1); however, that the medium is able to be adhered to a surface of a composite is not germane since it has been held that an element that is “being able to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. Further, the instant limitations are also intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6379761 B1 to Brandt et al. in view of US 5,891,552 to Lu et al.

Brandt teaches a heat (thermal) transfer label for adhering to a container (medium for adhering to a surface of a composite), where the label shown in Fig. 1 and associated text comprises a silicone release (2) coated film (1) with layers of ink (4). Brandt explains the film substrate 1 which may be any thin film and the printed ink materials contain as many as five 5 different colors in one or more layers, which may overlay another (because the colors are different and one is white, it embraces the light (white) and dark colored inks and the obscuring sufficiency of claims 1, 11). See 5:20-25. Brandt does not teach the “for adhering to a surface of a composite material of reinforcing material and a matrix” (instant claim 1) and the color of the composite (claims 9-10), however, that the medium is able to be adhered to a surface of a composite is not germane since it has been held that an element that is “being able to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. Further, the instant limitations are also intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Brandt teaches a transfer label where the ink is transferred and printed, while not stating it is printed with thermal transfer printer ink, the ink indicia is derived from a thermal printer which is a

process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

Brandt does not expressly teach said polymer carrier film is a mesh or a resin material that is used to adhere the medium to it, (instant claim 1, 4-5) or a light obscuring ink (claim 11).

Lu teaches a medium having thermal printed ink on plastic film substrate wherein the film is adhered to an object such as a clear plastic container and has any conventional glue or adhesive (resin layer) applied to the printed film so that it can adhere to the plastic container and be read. The substrate carrier is of polypropylene or paper (consistent with mesh as applicant uses within the specification on page 4, lines 25-26), or spunbonded polyolefin fiber. See 6:55-68, 7:25-30, 8:5-68. The ink includes particle pigmentation such as metallic pigments that reflect light (and thus functions to obscure color) and the concentration of the pigments is dependent upon the desired degree of translucency or opacity. See 4:40-68, 6:55-68, 7:25-30, 8:5-68.

It would have been obvious to one having ordinary skill in the art to have modified the medium of Brandt to include, use, or substitute a mesh, and resin layer as claimed because Lu teaches the paper and polymer film carriers are equivalents used for the same purpose and teaches thermal printed images on the medium employing an adhesive resin layer to attach a similar medium in order to for print to be read from a container and to include metallic pigments in ink to arrive at the desired degree of translucency or opacity as taught by Lu above.

The combination does not teach the thread counts recited in claim 3; however, the limitations are optimizable features. It would have been obvious to one having ordinary skill in the art to have modified the combination to have the recited amounts of threads/in since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. In re boesch, 617 F.2d 272,205 USPQ 215(CCPA 1980).

Claims 30-41 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6379761 B1 to Brandt et al. in view of Lu et al. and further in view of US 5,705,242 to Andersen et al.

The features of Brandt and Lu have been set forth above.

The combination does not teach the composite material (for adhering to a surface of a composite material of reinforcing material and a matrix) of instant claims 30 and 35.

Andersen teaches a container where it is comprised of synthetic binders and inorganic aggregate materials (the mixture equivalent to a matrix) and fibers of glass, carbon, metal, and other inorganic materials to reinforce the container (embraces fiberglass, carbon-carbon, and carbon reinforcing materials). See 5:50-65, 6:15-38, 7:5-40, 9:1-10. Such description is considered to embrace the claimed composite material as claimed.

It would have been obvious to one having ordinary skill in the art to have modified the combination to include, use, or substitute fiberglass and carbon fibers as claimed because Andersen teaches they are used as the materials to reinforce food and beverage containers as taught above and Lu suggested the adherence of a thermal printed label on a container so the container can be read as cited above.

The combination does not teach the thread counts recited in claim 33; however, the limitations are optimizable features. It would have been obvious to one having ordinary skill in the

art to have modified the combination to have the recited amounts of threads/in since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980).

Claims 3-5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5569347 A to Obata et al. in view of Lu et al.

Obata essentially teaches the claimed invention set forth above.

Obata does not teach the color of the composite (claims 9-10), however, that the medium is able to be adhered to a surface of a composite is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Further, the instant limitations are also to intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Obata does not expressly teach a resin material to adhere the medium to it, (instant claim 4-5), or a light ink obscuring dark ink per instant claim 11.

Lu teaches a medium having thermal printed ink on plastic film substrate wherein the film is adhered to an object such as a clear plastic container and has any conventional glue or adhesive (resin layer) applied to the printed film so that it can adhere to the plastic container and be read.

The substrate carrier is of polypropylene or paper (consistent with mesh as applicant uses within the specification on page 4, lines 25-26), or spunbonded polyolefin fiber. The ink includes particle pigmentation such as metallic pigments that reflect light (and thus functions to obscure color) and the concentration of the pigments is dependent upon the desired degree of translucency or opacity. See 4:40-68, 6:55-68, 7:25-30, 8:5-68.

It would have been obvious to one having ordinary skill in the art to have modified the medium of Obata to include a mesh, resin layer and a light obscuring ink as claimed because Lu teaches the paper and polymer film carriers are equivalents used for the same purpose and teaches thermal printed images on the medium employing an adhesive resin layer to attach a similar medium in order to for print to be read from a container and to include metallic pigments in ink to arrive at the desired degree of translucency or opacity as taught by Lu above.

The combination does not teach the thread counts recited in claim 3; however, the limitations are optimizable features. It would have been obvious to one having ordinary skill in the art to have modified the combination to have the recited amounts of threads/in since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. In re boesch, 617 F.2d 272,205 USPQ 215(CCPA 1980).

Claims 30-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5569347 A to Obata et al. in view of Lu et al. and further in view of US 5,705,242 to Andersen et al.

The features of Obata and Lu have been set forth above.

Further to claim 39, Obata does not expressly state a bar code, however Obata does state the ink is printed and thus the content of the ink is non-limiting.

The combination does not teach the composite material of reinforcing material and a matrix of fiberglass as claimed (instant claim 35); while Obata generally teaches the label medium adhered to a receptor.

Andersen teaches a container where it is comprised of synthetic binders and inorganic aggregate materials (the mixture equivalent to a matrix) and fibers of glass, carbon, metal, and other inorganic materials to reinforce the container (embraces fiberglass, carbon-carbon, and carbon reinforcing materials). See 5:50-65, 6:15-38, 7:5-40, 9:1-10. Such description is considered to embrace the claimed composite material as claimed.

It would have been obvious to one having ordinary skill in the art to have modified the combination to include, use, or substitute fiberglass and carbon fibers as claimed because Andersen teaches they are used as the materials to reinforce food and beverage containers as taught above and Lu suggested the adherence of a thermal printed label on a container so the container can be read as cited above.

The combination does not teach the thread counts recited in claim 33; however, the limitations are optimizable features. It would have been obvious to one having ordinary skill in the art to have modified the combination to have the recited amounts of threads/in since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. In re boesch, 617 F.2d 272,205 USPQ 215(CCPA 1980).

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Due to Applicant's amendments to the claims, the arguments to the new limitations are moot in view of the new art applied above using all new references.

Applicant's contrary position is noted to the process of thermal printing, but other than alleging the products are distinguished, no evidence is provided to show a material difference and the Examiner recognizes none.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Tamra L. Dicus /TLD/
Examiner
Art Unit 1794

January 15, 2008



MILTON I. CANO
SUPERVISORY PATENT EXAMINER